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EXAMINER

BERNATZ, KEVIN M

ART UNIT PAPER NUMBER

1773

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/746,056

Applicant(s)

LEHTONEN, JARMO

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-46, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-46, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/3/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to the specification and claims 17, 19, 20 and 46, cancellation of claims 47 and 48, and addition of new claims 49 and 50, filed on January 3, 2005, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Examiner's Amendment***

3. The Examiner notes that the claim designator for claim 46 has been changed from "Currently presented" (which is not an allowed claim designator) to "Currently amended".

### ***Examiner's Comments***

4. The Examiner's interpretation of "interference effect" recited in Paragraph 4 of the Office action mailed May 11, 2004 has been maintained. While applicants argue a narrower interpretation of the recited language, the Examiner does not find any evidence supporting applicants' position. First, the Examiner notes that independent claims 17 and 41 do not require the alleged limitations (i.e. claim 17 does not require the interference effects to be at the same wavelengths and claim 41 does not require transparent coatings). Applicants allegation that "it is not true that an interference effect

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can be produced by absorption of light by the coating", the Examiner notes that while applicants are allowed to be their own lexicographer, applicants must explicitly define such terms in their as-filed specification if they are not utilizing the broadest reasonable definition consistent with the written description as it would be interpreted by one of ordinary skill in the art. Given the example in the specification, the Examiner maintains that one of ordinary skill in the art, upon reading the as-filed specification, would necessarily grant the term "interference effect" the broadest reasonable definition as recited by the Examiner in Paragraph 4 of the Office action mailed May 11, 2004. Applicants' argument that a "coating which absorbs light is not transparent and/or cannot reflect light" is not found convincing since "transparent" is not claimed ("substantially transparent" is what is claimed) and very few absorbers are perfect absorbers/"black bodies" and almost all coatings will exhibit a combination of absorption, reflection and transmission.

5. Regarding the limitation(s) "substantially transparent" in claims 17 and 46, the Examiner has given the term(s) the broadest reasonable interpretation(s) consistent with the written description in applicants' specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994). See MPEP 2111. Specifically, while the limitation "substantially" is a relative term, the Examiner deems that one of ordinary skill in the art would recognize that "substantially" encompasses both fully transparent materials, as well as translucent materials (including "opaque" materials if sufficiently thin to allow

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light to transmit through them), since such materials allow for non-nominal light to pass through them (i.e. are "substantially" transparent).

### ***Specification***

6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### ***Arrangement of the Specification***

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if

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the required "Sequence Listing" is not submitted as an electronic document on compact disc).

7. For further clarification, the above sections are denoted in more detail below:

**Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.  
  
Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

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- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

### ***Claim Objections***

8. Claims 3, 14 and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Regarding claim 3, the Examiner notes that base claim 46 already discloses the claimed limitations and the scope of claim 3 is identical to that of claim 46.

Regarding claim 14, the Examiner notes that since "first" and "second" are mere nomenclature and have no additional structural limitations directed to them, the scope covered by claim 14 is identical to that of claim 11.

Regarding claim 19, the Examiner notes that base claim 17 already discloses the claimed limitations and the scope of claim 19 is identical to that of claim 17.



***Claim Rejections - 35 USC § 112***

9. Claims 2 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 18 recite that "one of said areas ... is ... uncoated", yet the base claim requires both areas to be coated. Since a dependent claim *requires* all the limitations of the base claim, this is inconsistent and one of ordinary skill in the art would not be readily appraised of the full scope covered by claim 2. Should applicants desire to claim embodiments wherein one of the areas is an uncoated area, applicants are suggested to either rewrite claim 2 in independent format or rewrite claim 46 to positively recite that the first and/or second interference effects can be derived either by the substantially transparent coating layer or by being an uncoated area. For purposes of evaluating the prior art, the Examiner has taken the base claim to allow for one of the interference effects to be formed by either a coating layer or an uncoated area. However, the Examiner notes that unless a reference teaches forming coating layers across the entire surface of the object, any uncoated area will then necessarily read on applicants' claimed area producing an interference effect.

***Claim Rejections - 35 USC § 102***

10. Claims 41 – 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Curiel (U.S. Patent No. 5,913,543) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on May 11, 2004.

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11. Claims 2, 3, 11 – 19, 21 – 29, 31 – 39, 46, 49 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Butland (U.S. Patent No. 5,360,628).

Regarding claims 3, 17, 19 and 46, Butland discloses an object comprise a first area and a second area on the surface of said object (*Abstract*), said object comprising an optical coating with a first substantially transparent coating layer (*col. 2, lines 43 – 55*) and a second substantially transparent coating layer (*col. 2, line 56 bridging col. 3, line 49*), wherein said first coating layer, on said first area has a thickness and optical properties for creating a first interference effect at a predetermined wavelength of visible light (*i.e. "a first mark or indicia which is readily perceptible to the naked or (mechanically) unaided eye"*), and said second coating layer on said second area, has a thickness and optical properties for creating a second interference effect at a/said predetermined wavelength of visible light (*i.e. "a second means of identification and/or verification is invisible to the owner"*), wherein said second interference effect is different from said first interference effect, and one of said first and second interference effects is visible, and the other is invisible to the naked eye (*Abstract and col. 2, lines 43 – 67*).

Regarding claims 2 and 18, since the disclosed areas are marks/indicia, the Examiner notes that there is plenty of additional non-coated areas which would meet applicants' claimed limitations.

Regarding claims 11 – 16, 21, 22, 26 – 29, and 31 - 37, these limitation(s) are intended use limitation(s) and are not further limiting in so far as the *structure* of the claimed product is concerned. Note that "in apparatus, article, and composition claims,

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intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the labeled object formed using the Butland invention can clearly be made to meet the claimed intended use limitations, since it is known in the art to label displays/packages/mobile telecommunication devices and to form such labels in the form of characters, graphics, symbols, trade marks and/or instructions

Regarding claims 23 and 24, Butland disclose coatings meeting applicants' claimed material/structural limitations (*col. 2, lines 50 – 55 and col. 3, lines 15 – 21*).

Regarding claims 38 and 39, the Examiner deems that Butland discloses using materials meeting applicants' claimed limitations (*col. 2, line 56 bridging col. 3, line 49*).

Regarding claims 49 and 50, Butland discloses the use of both areas which comprise reflection of predetermined wavelengths of light (*col. 2, line 64 bridging col. 3, line 21*) and other areas which are deemed to produce interference effects by destructive interference (*col. 2, lines 43 – 55*).

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12. Claims 17 – 24, 26 – 37 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Dobrowolski et al. (U.S. Patent No. 5,009,486).

Regarding claims 17 and 19, Dobrowolski et al. disclose an object comprise a first area and a second area on the surface of said object (*Abstract and col. 4, lines 41 - 66*), said object comprising an optical coating with a first substantially transparent coating layer (*col. 4, lines 41 – 50; col. 5, lines 29 – 33; Table on columns 5 – 6; and col. 7, lines 18 - 67*) and a second substantially transparent coating layer (*col. 4, lines 61 – 66; col. 5, lines 29 – 33; Table on columns 5 – 6; and col. 7, lines 18 - 67*), wherein said first coating layer, on said first area has a thickness and optical properties for creating a first interference effect at a predetermined wavelength of visible light, and said second coating layer on said second area, has a thickness and optical properties for creating a second interference effect at a/said predetermined wavelength of visible light, wherein said second interference effect is different from said first interference effect (*i.e. "at least one additional, optical interference, contrast coating, the materials and thickness which are selected so that these coatings have different known spectral transmission and spectral reflectance to the other coatings"*).

Regarding claim 18, since the disclosed areas can be marks/indicia (*Figure 1*), the Examiner notes that there is plenty of additional non-coated areas which would meet applicants' claimed limitations.

Regarding claim 20, Dobrowolski et al. disclose multiple coating areas on at least one area (*Figures*).

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Regarding claims 21, 22, 26 – 29, and 31 - 37, these limitation(s) are intended use limitation(s) and are not further limiting in so far as the *structure* of the claimed product is concerned. Note that “in apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.***

In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the labeled object formed using the Butland invention can clearly be made to meet the claimed intended use limitations, since it is known in the art to label displays/packages/mobile telecommunication devices and to form such labels in the form of characters, graphics, symbols, trade marks and/or instructions

Regarding claims 23 and 24, Dobrowolski et al. disclose coatings meeting applicants’ claimed material/structural limitations (*col. 4, lines 41 - 50*).

Regarding claim 30, Dobrowolski et al. disclose thickness values meeting applicants’ claimed range limitations (*col. 4, lines 47 – 50*).

Regarding claim 50, Dobrowolski et al. disclose the use of both areas which comprise reflection of predetermined wavelengths of light and other areas which are deemed to produce interference effects by destructive interference (*Abstract and Figures*).

***Claim Rejections - 35 USC § 103***

13. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curiel as applied above, and further in view of Pennace (U.S. Patent No. 5,296,949) for the reasons of record as set forth in Paragraph No. 13 of the Office Action mailed on May 11, 2004.

14. Claims 4 – 6 and 8 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butland as applied above, and further in view of Prince et al. (U.S. Patent No. 5,605,759) and Dobrowolski (EP 181,770 A2).

Butland is relied upon as described above.

Butland fails to disclose the claimed coating methods.

However, the claimed coating methods are all known coating methods for applying diverse coatings to surfaces (*see Dobrowolski, page 18, line 32 bridging page 19, line 1 and Prince et al., Title and col. 2, lines 53 – 64*). The Examiner deems that the determination of an appropriate coating/deposition technique would be within the knowledge of one of ordinary skill, depending on the type of coating to be applied, the cost of the coating method and the production facilities available.

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Butland to utilize a deposition/coating technique known in the art to one of ordinary skill, depending on the type of coating to be applied, cost and production facilities available.

15. Claims 7, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butland as applied above, and further in view of Dobrowolski et al. ('486).

Butland is relied upon as described above.

Regarding claim 20, Butland fails to disclose multiple coating layers on one area.

However, Dobrowolski et al. teach that one can use multiple coating layers to achieve symbols/markings that have different spectral characteristics to make copying more difficult (*Abstract*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant(s) invention to modify the device of Butland to form areas having multiple coatings as taught by Dobrowolski et al. in order to make the markings more difficult to copy.

Regarding claim 7, the Examiner notes that Dobrowolski et al. teach that one of ordinary skill in the art would recognize that tinting a coating can be used to achieve a colored layer, thereby obtaining additional colored effects which may increase the difficulty in reproducing the marking (*col. 1, lines 38 – 41*).

Regarding claim 30, Dobrowolski et al. teach the importance of using coating layers meeting applicants' claimed thickness values (*col. 4, lines 47 - 50*), wherein one of ordinary skill in the art would recognize that the thickness of the film directly impacts the optical properties of the film and any films above or below it. The Examiner deems that it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a results effective variable such as the coating layer

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thickness through routine experimentation, especially given the teaching in Dobrowolski et al. regarding the desire to use coating layers meeting applicants' claimed thickness limitations. *In re Boesch*, 205 USPQ 215 (CCPA 1980); *In re Geisler*, 116 F. 3d 1465, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); *In re Aller*, 220 F.2d, 454, 456, 105 USPQ 233, 235 (CCPA 1955).

16. Claims 38 – 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butland as applied above, and further in view of the state of the prior art as evidenced by Lasch et al. (U.S. Patent App. No. 2002/0145049 A1).

Butland is relied upon as described above.

Butland fails to explicitly disclose using inks meeting applicant's claimed luminescent limitations, though Butland recognizes using "hidden" inks that display luminescent properties (*col. 2, line 56 bridging col. 3, line 10*).

The Examiner deems that using luminous inks/materials is a matter of obvious design choice known to one of ordinary skill in the art, as evidenced by Lasch et al., (*Paragraphs 0038 and 0045*), depending on the desired aesthetics of the finished product.

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Butland to utilize a luminous material meeting applicant's claimed limitations, since it is an obvious matter of design choice within the knowledge of one of ordinary skill in the art.



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17. Claims 2 – 4, 7, 10 – 16, 25, 46 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobrowolski et al. as applied above, and further in view of Butland ('628).

Dobrowolski et al. is relied upon as described above.

Regarding claims 3 and 46, Dobrowolski et al. fail to teach using one visible and one invisible coating.

However, Butland teaches that using one visible marker and one invisible marker provides improved protection from duplication (*Abstract*), and it would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Dobrowolski et al. to use a coating meeting applicants' claimed limitations as taught by Butland, since such a coating provides additional protection from duplication.

Regarding claim 2, since the disclosed areas can be marks/indicia (*Figure 1*), the Examiner notes that there is plenty of additional non-coated areas which would meet applicants' claimed limitations.

Regarding claims 4 and 10, Dobrowolski et al. disclose coating methods meeting applicants' claimed limitations (*col. 8, lines 26 – 34*).

Regarding claim 7, the Examiner notes that Dobrowolski et al. teach that one of ordinary skill in the art would recognize that tinting a coating can be used to achieve a colored layer, thereby obtaining additional colored effects which may increase the difficulty in reproducing the marking (*col. 1, lines 38 – 41*).

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Regarding claims 11 – 16, these limitation(s) are intended use limitation(s) and are not further limiting in so far as the *structure* of the claimed product is concerned. Note that “in apparatus, article, and composition claims, intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the labeled object formed using the Butland invention can clearly be made to meet the claimed intended use limitations, since it is known in the art to label displays/packages/mobile telecommunication devices and to form such labels in the form of characters, graphics, symbols, trade marks and/or instructions

Regarding claim 25, Butland teaches that using a hologram (i.e. a “coating comprising coating layers in order to create a three-dimensional space effect”) is especially preferred as the visible marking, since holograms are harder to replicate (*col. 2, lines 50 – 55*).

Regarding claim 49, Dobrowolski et al. disclose the use of both areas which comprise reflection of predetermined wavelengths of light and other areas which are deemed to produce interference effects by destructive interference (*Abstract and Figures*).

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18. Claim 5, 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobrowolski et al. in view of Butland as applied above, and further in view of Prince et al. ('759) and Dobrowolski (EP '770 A2).

Dobrowolski et al. and Butland are relied upon as described above.

Neither of the above disclose using a coating meeting applicants' claimed limitations.

However, the claimed coating methods are all known coating methods for applying diverse coatings to surfaces (see *Dobrowolski*, page 18, line 32 bridging page 19, line 1 and *Prince et al.*, Title and col. 2, lines 53 – 64). The Examiner deems that the determination of an appropriate coating/deposition technique would be within the knowledge of one of ordinary skill, depending on the type of coating to be applied, the cost of the coating method and the production facilities available.

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Dobrowolski et al. in view of Butland to utilize a deposition/coating technique known in the art to one of ordinary skill, depending on the type of coating to be applied, cost and production facilities available.

19. Claims 38 – 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobrowolski et al. in view of Butland as applied above, and further in view of the state of the prior art as evidenced by Lasch et al. ('049 A1).

Dobrowolski et al. and Butland are relied upon as described above.

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Neither of the above explicitly disclose using inks meeting applicant's claimed luminescent limitations, though Butland recognizes using "hidden" inks that display luminescent properties (*col. 2, line 56 bridging col. 3, line 10*).

The Examiner deems that using luminous inks/materials is a matter of obvious design choice known to one of ordinary skill in the art, as evidenced by Lasch et al., (*Paragraphs 0038 and 0045*), depending on the desired aesthetics of the finished product.

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Dobrowolski et al. in view of Butland to utilize a luminous material meeting applicant's claimed limitations, since it is an obvious matter of design choice within the knowledge of one of ordinary skill in the art.

### ***Response to Arguments***

**20. The prior rejection of claims 2 – 40 and 46 - 48 under 35 U.S.C § 102(e) and/or 103(a) – Curiel, alone or in view of various references**

The above noted rejection has been withdrawn because applicant(s) amendment(s) have set forth new limitations (e.g. "substantially transparent") no longer anticipated, nor rendered obvious, by the above noted rejection.

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**21. The rejection of claims 41 - 45 under 35 U.S.C § 102(e) and/or 103(a) –  
Curiel, alone or in view of Pennace**

Applicant(s) argue(s) that “there is absolutely no disclosure or suggestion in Curiel of applying first and second transparent optical coatings” (*page 12 of response*), that “the present invention employs two coatings which are transparent” and “which create different interference effects at the same wavelength of visible light” (*page 13 of response*) and that “prior art of record differs critically from the present method and product claims which employ at least two different interference effects ... having different interference effects in transparent coatings at the same wavelength of visible light, without any requirement for removing any portions of the optical coatings”, thereby distinguishing the claimed invention from Curiel. The examiner respectfully disagrees.

The Examiner notes that none of the above limitations are present in claims 41 – 45, hence rendering applicants’ arguments moot. Furthermore, the Examiner notes that many of the argued limitations are not present in the claims, and applicants are reminded that the specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

**Conclusion**

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicants' amendment resulted in embodiments not previously considered (i.e. "substantially transparent") which necessitated the new grounds of rejection, and hence the finality of this action.

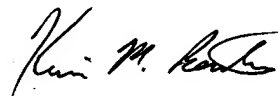
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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KMB  
March 4, 2005

  
Kevin M. Bernatz, PhD  
Primary Examiner